

DOCKET NO.: ISIS-1158



03/18/05

163/ft

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

**Nielsen, et al**

Application No.: **08/319,411**

Filing Date: **October 6, 1994**

For: **Peptide Nucleic Acid Conjugates**

Confirmation No.: **8648**

Group Art Unit: **1631**

Examiner: **Ardin H. Marschel**

EXPRESS MAIL LABEL NO: EL 998520197 US  
DATE OF DEPOSIT: March 17, 2005

EL 998520197 US

MS Amendment  MS AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**REPLY TRANSMITTAL LETTER**

- A Preliminary Amendment.
- A Reply Responsive to the Office Action Dated October 6, 2004.
- A Reply Supplemental to the Paper filed
- A Substitute Specification (pages 1 - ) in clean form.
  - A substitute specification (pages 1 - ) with markings.
- An Abstract is enclosed.
- replacement sheets of drawings are enclosed comprising figures
- Request is hereby made to accept black and white photograph(s) in this case, as they are the only practicable medium for illustrating the claimed invention. One (1) set of black and white photographs comprising figure(s) is submitted herewith.
- Petition is hereby made to accept drawing(s)/photograph(s) in this case.

- Three (3) sets of color drawing(s)/photograph(s) and black and white photocopy that accurately depicts to the extent possible, the subject matter shown in the color drawing(s)/photograph(s), are enclosed, comprising figures
- An amendment to the first paragraph in that portion of the Brief Description of the Drawings is also enclosed herewith advising that the patent contains at least one drawing/photograph in color.
- A Certified Copy of each of the following applications: \_\_\_\_\_ is enclosed.
- An Associate Power of Attorney is enclosed.
- Information Disclosure Statement.
  - Attached Form 1449.
  - A copy of each reference as listed on the attached Form PTO-1449 is enclosed herewith.
- A Terminal Disclaimer is attached.
- Appendices as follows:
- Other: Applicant-Initiated Interview Summary
- No Additional Fee is Due.**
- Applicant(s) has previously claimed small entity status under 37 CFR § 1.27.
- Applicant(s) by its/their undersigned attorney, claims small entity status under 37 CFR § 1.27 as \_\_\_\_\_.
- This application is no longer entitled to small entity status. It is requested that this be noted in the files of the U.S. Patent and Trademark Office.

Best Available Copy

	REMAINING AFTER AMENDMENT	HIGHEST PAID FOR	EXTRA	RATE	SMALL ENTITY FEE	NOT SMALL ENTITY FEE
TOTAL CLAIMS	3	36 (20 MINIMUM)	0	\$25 EACH	\$	\$50 EACH \$0.00
INDEP. CLAIMS	1	15 (3 MINIMUM)	0	\$100 EACH	\$	\$200 EACH \$0.00
FIRST PRESENTATION OF MULTIPLE DEPENDENT				\$180	\$	\$360 \$0.00
<input type="checkbox"/> ONE MONTH EXTENSION OF TIME				\$60	\$	\$120 \$0.00
<input type="checkbox"/> TWO MONTH EXTENSION OF TIME				\$225	\$	\$450 \$0.00
<input checked="" type="checkbox"/> THREE MONTH EXTENSION OF TIME				\$510	\$	\$1020 \$1,020.00
<input type="checkbox"/> FOUR MONTH EXTENSION OF TIME				\$795	\$	\$1590 \$0.00
<input type="checkbox"/> FIVE MONTH EXTENSION OF TIME				\$1080	\$	\$2160 \$0.00
<input type="checkbox"/> LESS ANY EXTENSION FEE ALREADY PAID				minus	(\$ )	minus (\$0.00)
<input type="checkbox"/> TERMINAL DISCLAIMER				\$65	\$	\$130 \$0.00
<input type="checkbox"/> OTHER FEE OR SURCHARGE AS FOLLOWS:						
TOTAL FEE DUE				\$		\$1,020.00

- A check in the amount of \$1,020.00 is attached. Please charge any deficiency or credit any overpayment to Deposit Account 23-3050.
- Please charge Deposit Account No. 23-3050 in the amount of .00. This sheet is attached in duplicate.
- Petition is hereby made under 37 CFR § 1.136(a) (fees: 37 CFR § 1.17(a)(1)-(4)) to extend the time for response to the Office Action of October 6, 2004 to and through April 6, 2005 comprising an extension of the shortened statutory period of Three (03) month(s).

- The Commissioner is hereby requested to grant an extension of time for the appropriate length of time, should one be necessary, in connection with this filing or any future filing submitted to the U.S. Patent and Trademark Office in the above-identified application during the pendency of this application. The Commissioner is further authorized to charge any fees related to any such extension of time to Deposit Account 23-3050. This sheet is provided in duplicate.

Date: March 17, 2005

John A. Harrelson, Jr.  
John A. Harrelson, Jr., Ph.D.  
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DATE OF DEPOSIT: March 17, 2005**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Applicant-Initiated Interview Summary**

Date of Interview: March 3, 2005

Interview Type:  Personal  Telephonic  Electronic Mail  Video Conference  Other:

Participants:

From PTO: (Include Name and Title)

1. Ardin H. Marschel, Primary Examiner

For Applicant:

1. Joseph Lucci, Attorney

An exhibit or demonstration was included and is described below:

The claims discussed included: Claim(s) 53, 63, and 64 generally

The  art  prior art discussed included:

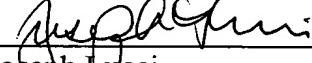
US Patent No. 5,773,571

An agreement  was  was not reached.

- It was agreed that the attached claims are allowable.  
 It was agreed that the attached amendment would be entered.  
 The interview is summarized below.

Mr. Lucci noted that the outstanding rejections for alleged obviousness-type double patenting do not satisfy the requirements of MPEP § 2144.08. He also noted that the mere fact that a claim under examination overlaps with a claim of an issued patent is not sufficient to support an obviousness-type double patenting rejection. For example, although claims 53, 63, and 64 stand rejected for alleged obviousness-type double patenting over claim 1 of US Patent No. 5,773,571, there is no reason to believe that those of ordinary skill having knowledge of the claim 1 would have found the instant claims to have been obvious.

Date: March 17, 2005

  
\_\_\_\_\_  
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